



Atty. Dkt. No. 069818-2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frans Nooren
Title: COMPOSITION FOR THE PROTECTION OF A SHAPED
ARTICLE AGAINST CORROSION
Appl. No.: 10/564,516
International Filing Date: 7/14/2004
371(c) Date: 1/13/06
Patent No.: 7,608,343
Grant Date: 10/27/2009
Examiner: Peter A. SZEKELY
Art Unit: 1796
Confirmation Number: 3460

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on October 27, 2009 as U.S. Patent No. 7,608,343.

The Patent Office determined that the patent was entitled to 441 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

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On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 711 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 741 days

(b) Total Applicant delay: 30 days

Final PTA Determination: 711 days

Applicants therefore respectfully request that the patent be accorded 711 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date December 3, 2009

By _____

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Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 069818-2900
 Application Number: 10/564516
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	01/13/2006	0		
Edit Delete	Application Is Now Complete	01/13/2006	0		
	14 month From Application date	03/13/2007	424		
Edit Delete	Non-Final Office Action	06/09/2008	878	454	
	Non-Final Office Action + 3 months	09/09/2008	970		
CLOSE WINDOW	ALL CASES				
ALL CASES	SELECT CASE				
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	09/22/2008	983		13
Edit Delete	Final Office Action	12/30/2008	1,082		
	3 Year Period Starts	01/13/2009	1,096		
Edit Delete	Final Office Action Response Received at PTO	03/23/2009	1,165		
Edit Delete	Notice of Allowance	04/03/2009	1,176		
	Notice of Allowance + 3 months	07/03/2009	1,267		
Edit Delete	Request for Withdrawal from Issuance	07/14/2009	1,278		
Edit Delete	Withdrawn from Issuance by PTO	07/20/2009	1,284		17
Edit Delete	Notice of Allowance	09/04/2009	1,330		
Edit Delete	Issue Fee Paid	09/18/2009	1,344		
Edit Delete	Patent Grant Date	10/27/2009	1,383	287	
	Totals:			741	30
	PTA:			711	

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Foley & Lardner LLP